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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anderson *et al.*  
Serial No.: 09/717,478  
Filed: November 20, 2000  
For: POINT OF CARE DIAGNOSTIC  
SYSTEMS  
Art Unit: 1641  
Examiner: Davis, D.

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TRANSMITTAL LETTER

Commissioner for Patents  
Arlington, VA 22202

Sir:

Transmitted herewith is a Petition pursuant to 37 C.F.R. §1.181 with a check for the  
requisite fee (\$130.00) for filing in connection with the above-identified application.

- ☒ The Commissioner is hereby authorized to charge any fee, including fees for an  
extension of time and for the petition, that may be due in connection with this  
and the attached papers or with this application during its entire pendency to  
Deposit Account No. 50-1213. A duplicate of this sheet is enclosed.

Respectfully submitted,  
HELLER EHRMAN WHITE & McAULIFFE LLP

By:

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OFFICE OF PETITIONS



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PETITION PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents  
Arlington, VA 22202

Dear Sir:

Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed November 26, 2002, in connection with the above-captioned application. This Petition is filed within two months of the mailing of the final rejection.

It is respectfully submitted that the Office Action mailed November 26, 2002, (hereinafter the Office Action), which was made Final, introduces new grounds of rejection of claims 1, 3-4 and 8-9 under 35 U.S.C. §103 that were not necessitated by amendment and that could have been applied in a previous Office Action. Therefore, the Action should not have been made Final.

For example, in the previous Office Action dated May 22, 2002, (hereinafter the previous Office Action), claims 1, 3-4 and 8-9 were rejected under 35 U.S.C. §102 as anticipated by Connolly (WO96/13707).

Prior to amendment, claim 1 recited:

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OFFICE OF PETITIONS

1. (Amended) A method for reading the surface of a test strip comprising an image, comprising:

scanning a reader head in a reflectance reader of to a first position over the surface comprising the image;

determining a first amount of light reflected from the surface comprising the image;

illuminating the surface with light of a first wavelength, and determining a second amount of light reflected from the surface;

illuminating the surface with light of a second wavelength, and determining a third amount of light reflected from the surface; and

determining a parameter correlated with the intensity or shape of the image.

Amended claim 1 reads as follows:

1. (Amended Twice) A method for reading [the] a surface of a test strip comprising an image, comprising:

[scanning] moving a reader head in a [reflectance] reflectance reader [of] to a first position over the surface comprising the image;

[determining] measuring a first amount of light reflected from the surface comprising the image;

uniformly illuminating the surface with light of a first wavelength, and [determining] measuring a second amount of light reflected from the surface; and

uniformly illuminating the surface with light of a second wavelength, and [determining] measuring a third amount of light reflected from the surface[; and

determining a parameter correlated with [the] an intensity or shape of the image].

It is clear that the meaning of "scanning" is the same as the meaning of "moving." For example, at page 46, lines 8-13, of the specification states:

the reader head **706** is moved (scanned) across the bar code and/or test strip.

Another example is found in the specification at page 47, lines 15-18, which states:

[t]he control circuit moves (scans) the head across the exposed surface of the bar code or test strip.

Thus, in accordance with teachings in the specification (as well as the ordinary meaning of words), the terms "scan" and "move" have similar meanings of changing the position of the reader head with respect to the surface of the test strip. Accordingly, amendment of claim 1 by substituting "moving" for

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"scanning," does not add an element. The element was present in claim 1 prior to amendment. The original claim included the requirement that the reader head change position with respect to the surface of the test strip and is the basis upon which the claims were distinguished from the cited reference Connolly in the previous response. Thus, the claims prior to amendment included a step of "scanning a reader head ... over the surface" of a test strip. (Claim 1, lines 3-4). In arguing the impropriety of the rejection, it was noted that Connolly cited in the previous Office Action does not anticipate the claims because it fails to disclose a method with a step of scanning a reader head over the surface of a test strip.

In the Final Office Action, claims 1, 3-4 and 8-9 are rejected under 35 U.S.C. §103 as being unpatentable over Connolly (WO96/13707) and Augstein (U.S. Patent 5,665,310) because Augstein allegedly teaches a reader head that can scan over a the surface of a test strip. Thus, the new ground for rejection is directed to an element already present in the claims prior to amendment. Accordingly, the new ground of rejection could have been applied in the previous Office Action and is not necessitated by amendment to the claims.

The Office Action indicates that the amendments to the claims necessitated the new grounds for rejection. The amendment to the claims, did not add the requirement that the reader head scan over the surface of the test strip. The amendment to claim 1, set forth above, changes the term "scanning" to the similar term "moving" in order to more distinctly indicate that the reader head changes position with respect to the surface of the test strip and was made in response to the various rejections under 35 U.S.C. 112, second paragraph. Therefore, the new ground is not necessitated by the amendment of claim 1, since the element of changing the position of a reader head (i.e., "scanning" or "moving") was present in the claims as pending prior to the amendment.

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Failure to withdraw the finality of the Office Action denies the Applicant the right to address the rejection, which could have been set forth in the previous non-final Office Action. Therefore, it is respectfully submitted that since the newly recited rejections of claims 1, 3-4 and 8-9 under 35 U.S.C. §103 are not necessitated by amendment and could have been raised in the previous Office Action, the finality of the Office Action is improper.

\* \* \*

In light of the above remarks, reconsideration and removal of the finality of the Office Action are respectfully requested.

Respectfully submitted,  
HELLER EHRMAN WHITE & McAULIFFE LLP

By:

  
Stephanie Seidman  
Registration No. 33,779

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